

### **REMARKS**

The Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1-13 are pending. No claims are amended. Claims 1, 2, 3, 4, 7 and 11 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the remarks set forth herein.

### **Examiner Interview**

The Applicant gratefully appreciates the courtesies extended to the Applicant's Representative, Carl T. Thomsen, Registration No.: 50,786 during the telephonic interview on August 18, 2005. In the interview the Applicant's Representative discussed specific changes to the Declaration Submitted Under 37 CFR § 1.131 that are intended to overcome the statements in the Office Action that "The declaration filed on March 18, 2005 under 37 C.F.R. 1.131 has been considered ineffective....". The new Declaration Submitted Under 37 CFR § 1.131 attached hereto has been revised along the lines of that discussed in the interview.

If further discussions with the Applicant's Representative would accelerate the prosecution of the present application, the Examiner is urged to contact Carl T. Thomsen, at 703-208-4030, who is available to assist the Examiner as appropriate.

### **Rejection Under 35 U.S.C. §102(a) and §103(a)**

Claim 2 stands rejected under 35 U.S.C. §102(e) as being anticipated by "Data Binding from XML to Java, Part 3", by McLaughlin (McLaughlin-3), published on September 14, 2000;

Claims 1 and 3-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "Data Binding from XML to Java, Part 4", by McLaughlin (McLaughlin-4), published on October 1, 2000; and

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over McLaughlin-4 in view of McLaughlin-3 as applied to claim 8 above, and in further view of "Data Binding from XML to Java, Part 2", by McLaughlin (McLaughlin-2), published in August 2000.

These rejections are respectfully traversed.

**Declaration Submitted Under 37 CFR § 1.131**

In the Office Action, the Examiner states that the Declaration submitted Under 37 CFR § 1.131 on March 18, 2005 is ineffective.

In response, the Examiner is directed to the new Declaration Submitted Under 37 CFR § 1.131 attached hereto, in which the Applicant states that the present application was fully conceived prior to January 26, 2000, and verifies the authenticity of several attached documents which demonstrate due diligence from the conception date to the filing date of the present invention on April 19, 2001.

This new Declaration Submitted Under 37 CFR § 1.131 includes 15 Exhibits, Exhibits 1-5 being included to establish conception prior to January 26, 2000, and Exhibits 6-15 to establish due diligence leading up to the filing date of the present application on April 19, 2001, April 19, 2001 being the date of constructive reduction to practice of the present invention.

MPEP Section 2138.06 states that "The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses". Recent case law further interprets that which constitutes "due diligence" under the law. For example, the diligence of 35 U.S.C. 102(g) relates to reasonable "attorney-diligence" and "engineering-diligence" (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that "an inventor or his attorney ... drop all other work and concentrate on the particular invention involved...."

See also *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter.1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by

relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”).

See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

The Applicant respectfully submits that conception prior to January 26, 2000, and due diligence leading up to the constructive reduction to practice on April 19, 2001, as documented in the attached Declaration under 37 CFR §1.131, and support by the relevant case law, has in fact been practiced by the parties involved with the present invention, including Lucent Technologies, AVAYA, Inc., and the outside counsel involved with the drafting of this application.

Therefore, inasmuch as McLaughlin-3 and McLaughlin-4 were published after the date of conception of the present invention, and due diligence was practiced leading up to the date of filing on April 19, 2001, these references cannot be used to reject any of independent claims 1, 2, 3, 4, or 7 of the present application.

Therefore, independent claims 1, 2, 3, 4, and 7 are in condition for allowance.

The rejection of claim 10 based on the combination of McLaughlin-4, McLaughlin-3 and McLaughlin-2, is now moot.

Dependent claims 5, 6, and 8-10 are also in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §§102(a) and 103(a) are respectfully requested. All claims of the present application are now in condition for allowance.

**CONCLUSION**

Since the remaining patents cited by the Examiner have not been utilized to reject claims, but merely to show the state of the art, no comment need be made with respect thereto.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 205-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 50-1602 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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Attachment: New Declaration Submitted Under 37 C.F.R. §1.131, including Exhibits 1-15